

UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/687,748  
Applicant : Abe Nishiki  
Filed : 10/20/2003  
TC/A.U. : 3734  
Examiner : Eric D. Blatt  
Customer No. : **51702**  
For : PLIERS-LIKE TOOL AND PROCESS FOR CURING PHIMOSIS

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PETITION UNDER 37 CFR 1.181**

Dear Sir:

This petition is to stop the examiner's incompetent retaliatory harassment and fraud that is now in its seventh year, wherein each response to an Office Action precipitates a new grounds of rejection no better than the former, including creative, non-existent problems, and refusal to provide an Examiner's Answer in response to paid for Appeal Briefs, denying the applicant the independent review he paid for and to which he is entitled.

It is not believed that anyone having a basic knowledge of patent law sufficient to possess full signatory authority would be incompetent enough to reject or sign off on the reopening of prosecution for any one of the 35 USC 112 or 35 USC 102 or 35 USC 103 rejections or compact prosecution procedures in issue that have now been in effect for half a century, let alone all four.

The only conclusion that can logically be reached is that retaliation and harassment and/or discrimination are involved as there are no legally sufficient reasons for the rejections and delays.

The issues are:

- I. Inexcusable Protracted Prosecution
- II. Incompetent Unsupportable Rejections
- III. Creative Reversal of Accepted Drawings
- IV. Fraudulent Refusal of Board Review

I. Inexcusable Protracted Prosecution

As a refresher on Compact Prosecution, a copy of the June 22, 1964 memo with accompanying guidelines for Compact Prosecution and 35 USC 112 first paragraph is enclosed, the degree to which their provisions have been ignored is obvious, Most of the other pertinent laws being violated are just as old in substance and application.

This application was filed 10/20/2003. A first office rejection was made on 01/04/07. In response to the response to the first rejection, a new grounds of rejection was made on 07/06/2007.

In response to the response to the second new grounds of rejection, a third new grounds of rejection was made on 12/28/2007.

In response to the third new grounds of rejection, an Appeal Brief was mailed on 03/19/2008.

In response to the Appeal Brief, a fourth new grounds of rejection was mailed on 10/02/2008.

In response to the fourth new grounds of rejection, a new Appeal Brief (Reply Brief) was mailed on 12/20/2008.

In response to the Reply Brief, the examiner made a fifth new grounds of rejection on 06/08/2010.

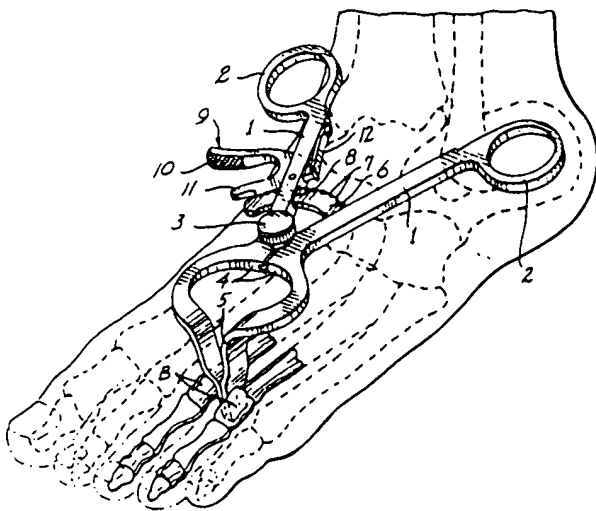
It would stand to reason that an examiner that can't make a valid rejection is not properly examining. An examiner that withdraws a rejection because it is shown to be bogus is admitting that it was not proper to begin with. An examiner that has to make a new grounds of rejection every time the rejection is shown to be bogus is incompetent and wasting everyone's time and money and contributes nothing to reducing the PTO backlog or fulfilling the Agency mission and its reason for existence.

## II. Incompetent Unsupportable Rejections

The line between making a valid rejection and pure harassment has long ago been crossed. With millions of references available to an examiner, there is no limit to the number of rejections available, and time and static that can be created, by an examiner. Compact Prosecution was intended to preclude such conduct.

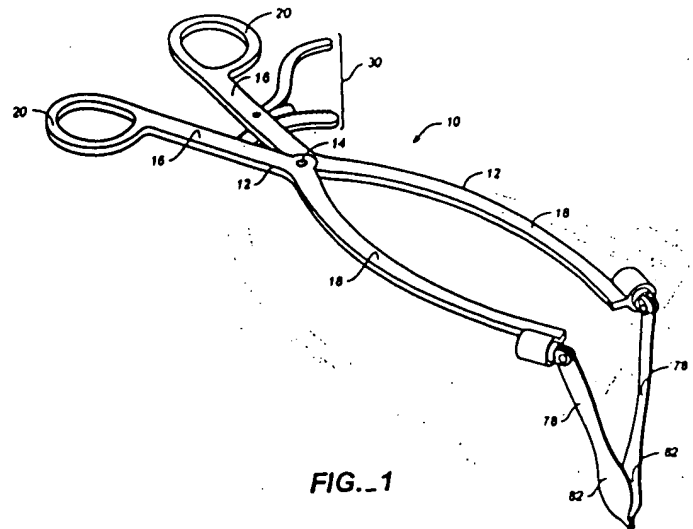
Addressing the latest in the series of indefensible rejections, it is worth comparing the rejection based on Cox in the second rejection (12/28/2007) with the latest based on Chang (06/08/2010). It is clear that while the rejection may be different it certainly is no better.

In the Office Action mailed 12/28/2007, the examiner rejected claims 1-3, 5 and 11-15 as being anticipated by Cox (U.S. 4,754,746). It was pointed out that Cox did not anticipate or make the claims obvious. A comparison between Cox (Fig.1) and Chang (Fig.1) reveals that the structure of Chang is no better than that of Cox, if in fact it is as good. Both devices have their terminal ends for placement around bones after which the grips are squeezed together to spread the jaws or arms.



*Fig. 1.*

Cox



**FIG. 1**

Chang

Chang (U.S. 6,663,562) is to a "SURGICAL RETRACTOR." The structure is similar to Cox previous addressed except that the blades 78 rotate parallel and perpendicular to the arm 18.

The Law applicable to 35 USC 102 rejections was addressed in the paragraph sharing pages 18 and 19 of the response to the office action mailed 01/04/2007, that was faxed on 04/02/2007, and again in the paragraph sharing pages 21 and 22 of the Appeal Brief mailed March 19, 2008.

The law applicable to 35 USC 103 was addressed on pages 19 through 23 of the response to the Office Action mailed 01/04/2007, that was faxed on 04/02/2007 and again on pages 22 through 27 of the Appeal Brief mailed March 19, 2008.

The case law cited in January and April of 2007 is as applicable today as it was then and continues to be ignored and violated.

As an example, lines 21–29 of claim 1 recite details of the “hook means” that are totally ignored, even though rejected under 35 USC 102. Such a blatant ignoring of the claim structure and law after being hand fed it reflects an attitude that extends beyond incompetence for anyone certified as an authority acting in behalf of the USPTO.

Your applicant has little choice but to believe he is being harassed and retaliated against for exposing the incompetent examination he is being subjected to. The second through fifth new rejections may be new but all fail to meet the claim structure and claim concept and not one is any better than any other one.

### III. Creative Reversal of Accepted Drawings

The examiner at this late date concludes that the claims contain subject matter that was not described in such a way as to enable one skilled in the art to ... make and/or use the invention.

It is stated that the pawl being attached to the second handle grip by a second pivot pin must be shown. Figs. 1, 9 and 10 all include the pivot pin 7.

It is more than a little disingenuous after three Office Actions affirming that the drawings are acceptable (page 1, Office Action of 01/04/2007, and again on page 1 of the Office Action mailed 07/06/2007, and again on page 1 of the Office Action mailed 12/28/2007) and almost seven years and an Appeal Brief to scrutinize the drawing, to nit-pick and raise or create an issue that no mechanic in the art, skilled or not, would have or misunderstand.

This prosecution history alone negates the examiner's newly perceived problems dealing with 35 USC 112 indefiniteness. Texas Instruments v. United States ITC, 10 USPQ 2d 1257 (Fed Cir 1989)

As well established, the specification is addressed to the mechanic in the art, not an incompetent idiot. The operation is perfectly obvious as explained and the examiner has speculated as to a confusion that is irrelevant and immaterial to the invention as disclosed and claimed. The examiner then proceeds to create a structure that is not present and that is envisioned to not operate. The overactive imagination when interpreting the prior art structure is bad enough but creating an inoperative, non-existent structure in the invention combination goes two steps beyond anything acceptable in the patent statutes. To even imply that the mechanic could be incapable of understanding the simple pawl and ratchet, in view of the hundreds in use for centuries, is an insult.

Note where a pivotal motion is optional no specific amount of pivot is set forth. A small pivot will facilitate removal of the pawl from the cog. This could be seen by looking at the cog shape and depression as seen in Fig. 5, for example. In any event, such is not properly in issue and is irrelevant.

Taking the concept one step further, attention is directed to the examiner's own reference, Chang (U.S. 6,663,562). In Fig. 1 there is shown a pawl 34 that pivots to and from a ratchet 32. Even though the specification recites "a pawl pivot 38," no such pivot can be found in the drawings. It is obvious that neither the present examiner nor the examining examiner was concerned about this trivial inconsequential omission. But then that examiner was not concerned about what could be an embarrassing Board of Appeals exposure of avoidance of a legally sound examination. It is clear the examiner has difficulty recognizing common art expedients on the one hand but has a wild creative imagination when bending non-existent structures in references.

The pertinent laws, all of which have been ignored and violated, include:

1. Rather than addressing the facts and specific claim wording subjective opinions have been made. Subjective opinions are of little weight against contrary evidence. In re Wagner et al., 152 USPQ 552 (CCPA 1967).
2. Even if some minimum experimentation on pivotability were necessary, such would not preclude patentability. In re Borkowski, 164 USPQ 642 (CCPA 1970).

3. Inventors can and do omit factors presumed to be within the level of ordinary skill in the art and the mere possibility of the inclusion of inoperative subject matter does not prevent allowance of broad claims. In re Cook and Merigold, 169 USPQ 298 (CCPA 1971).

4. The examiner has suggested no plausible reason the term and use of “pitoval” is anything other than as stated in the specification and standard practice. Such a contrary reading is not permissible. In re Salem, 193 USPQ 58 (CCPA 1980); In re Marosi, 218 USPQ 289 (FedCir 1983); In re Kohler et al, 204 USPQ 702 (CCPA 1980); In re Sneed, 218 USPQ 385 (FedCir 1983); In re Prater, 162 USPQ 541 (CCPA 1969).

5. Even if broad claims cover one or more inoperative species, the burden is on the examiner to show that the claims cover inoperative species and not on the applicant to show that it does not. In re Vickers and Herman, 61 USPQ 122 (CCPA 1944).

6. With respect to the specification and claims, they are addressed to the person of average skill in the particular art. Compliance with 112 must be adjudged from that perspective, not in a vacuum. It is always possible to theorize some combination of circumstance which would render a claim inoperative but those skilled in the art would assuredly not choose such a combination. It is not the function of claims or specifications to exclude all inoperative substances; it is not a valid basis for rejection that it is possible to argue that claims encompassed inoperative embodiments on the premise of unrealistic or vague assumptions Ex parte Cole, Howarth and Redding, 223 USPQ 95 (PO BdApp 1983); Ex parte Janin, 209 USPQ 761 (PO BdApp 1979); In re Bode, Nolan, Baker, Mathias and Pfaender, 193 USPQ 12 (CCPA 1977).



7. The Board of Appeals has stated that they will not affirm the examiner on a rejection that is based on suspicion of inoperativeness. Ex parte Adams, 77 USPQ 482 (POBA 1947).

The examiner's imaginary problem and objections find no support in fact or law.

#### IV. Fraudulent Refusal of Board Review

The previous rejection having been determined to be indefensible, the examiner has abandoned it to start all over again. The new rejection is no better than the last.

In view of long accepted PTO law and practice your applicant is of the opinion that he is being subjected to unacceptable harassment and retaliation for filing an Appeal Brief, in an effort to cover up unsupportable shoddy examination rejections.

The examiner made a third new grounds of rejection in this application on 12/28/2007. To put a stop to the ridiculous perpetuation of prosecution in this application filed on 10/20/2003, an appeal brief was mailed 03/19/2008. Rather than respond directly to the Appeal Brief, the examiner chose to respond by making a fourth new grounds of rejection on 10/02/2008 in response to the Appeal Brief. The fourth new grounds of rejection and first new grounds of rejection after the filing of a Brief defrauded your applicant of the Board of Appeals review he paid for and was entitled to. The fourth new grounds of rejection was responded to by a Reply Brief mailed 12/20/2008. The examiner sat on the Reply Brief until 06/08/2010, a year and a half, and once again, rather than responding to the Reply Brief directly, made a fifth new grounds of rejection that was approved by the SPE.

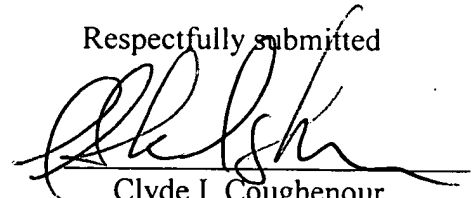
Your applicant has been harassed and defrauded out of his appeal fees and has been subjected to multiple unnecessary prosecution preparation fees by not being given a Board of Appeals review. This offer of an appellate review for a fee with acceptance of the money and failure or refusal to deliver the paid for service is seen to be an out and out fraud.

### CONCLUSION

It is requested:

- A. That the retaliation and harassing prosecution of this application be stopped.
- B. That the examiner be directed to promptly conclude prosecution of this application.
- C. That the examiner's determination that the drawing disclosure is in violation of 35 USC 112 be overturned.
- D. That the examiner be directed to promptly issue this application or prepare an Examiner's Answer, and that this application be sent to the Board of Appeals for their review of these issues.

Respectfully submitted



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UNITED STATES GOVERNMENT

U.S. DEPARTMENT OF COMMERCE  
PATENT OFFICE

# Memorandum

TO : Patent Examining Corps

DATE: June 22, 1964

FROM : H. B. Whitmore, *H. B. Whitmore*  
Superintendent of the Examining Corps

SUBJECT: Optimum Examining Procedure Memorandum #4  
REVISED EXAMINING PROCEDURES EFFECTIVE July 1, 1964

In the last few years, examining procedures have been extensively revised for the purpose of reducing to a minimum the total examining time necessary to bring each application to an equitable conclusion.

Under the broad title of compact prosecution, the guiding principle has been cooperative effort by Office and all applicants and patent practitioners to do everything essential to bring every case to an equitable conclusion in the minimum total time.

On June 8, 1964 Commissioner Edward J. Brenner in an address to the Examining Corps outlined further revisions of procedure which will become effective July 1, 1964, designed to reduce further both the processing time needed for each application and its total time of pendency in the Patent Office.

This Optimum Examining Procedure Memorandum #4 specifies the procedures by which the new policies will be effectuated. Issued to all employees in the Examining Corps on June 22, 1964, it will be published in an early issue of the Official Gazette for the information of the public.

By direction of the Commissioner, the procedures of this Memorandum override and replace any contrary directives either in the Manual of Patent Examining Procedure, or in OEP Memoranda #1, #2 and #3 previously issued.

It is hoped that a completely revised issue of the MPEP may be possible soon.

(1) The first major change under Commissioner Brenner's program concerns the priority of examination for pending applications. Like the "third action special" program followed since 1961, it is directed toward disposing of older cases more quickly, but goes much farther.

Hereafter, each examiner will give priority to that application in his docket, whether amended or new, which has the oldest effective U. S. filing date. Except as rare circumstances may justify Group Supervisors in granting individual exceptions, this basic policy applies to all applications.

Whether a given application has an effective U. S. filing date earlier than its actual filing date is determined by whether the disclosure of a parent case adequately supports any claim or claims of the later case. Examiners are responsible for making this determination. If at any time an examiner determines that the "effective filing date" status of any application differs from what the records show, he should so inform the Clerk of Group, who should promptly amend the records to show the correct status, with the date of correction.

The new order of examination for each examiner will continue top priority for those special cases having a fixed 60-day due date, such as Examiner's Answers and Decisions on Motions. Most other cases still remaining in the "special" category (for example, reissues, interference cases, cases made special by petition, cases ready for final conclusion, etc.) will continue in this category, with the first effective U. S. filing date normally controlling priority.

(2) The second major change involves the "more thorough first action" feature of compact prosecution. The heavy emphasis upon this more thorough first action is continued.

In addition, however, policy now emphasizes that the examiner wherever possible must point out allowable claims or claimed subject matter or ways in which claims might be amended to make them allowable.

Further, while interviews before a first response are normally discouraged, an examiner's suggestion of allowable subject matter may justify his indicating the possible desirability of an earlier interview to accelerate early agreement on allowable claims.

The first search should be such that the examiner need not ordinarily make a second search of the prior art, unless necessitated by amendments to the claims by the applicant in the first response, except to check to determine whether any reference which would appear to be substantially more pertinent than the prior art cited in the first Office action has become available subsequent to the initial prior art search. It should cover the invention as described and claimed, including the inventive concepts toward which the claims appear to be directed. It should not be extended merely to add immaterial variants.

While attorneys note favorably a higher proportion of better first actions now being received, they comment also that too many superficial or poorly phrased first actions leave them still at sea about the examiner's full attitude.

It is of highest importance, therefore, that this and later actions cover completely the questions of major importance, namely (1) whether there is adequate disclosure to support a patent, and (2) whether any inventive subject matter present is defined adequately to support a legally enforceable contract.

Intensive effort by individual examiners and by those in supervisory position to aid and direct examiners in adopting the most effective and rapid examining procedures for each action is urgently needed. The Commissioner has stated that success in our drive for improvement will hinge on "the capability and willingness of each examiner to accept new methods and ideas in practice and procedure, and to wholeheartedly implement new concepts."

Shortening the time of prosecution following the first action is the major objective of the third and fourth major changes.

(3) The third change requires that, except in rare circumstances where the Group Supervisors may authorize exceptions, all second actions on the merits shall be final.

Current experience indicates that with the full cooperation of the applicant, this measure can be adopted without sacrificing any of applicant's rights.

For foreign applicants, the practice explained in Item 2 of OEP Memorandum #3, published April 14, 1964, 801 O. G. 267, gives full protection for those who comply with U. S. Patent Office procedural requirements.

Attorneys who have cooperatively revised their own procedures to incorporate in their first responses all changes of whatever character which they consider necessary to make each application completely ready for issue or appeal, regardless of what the examiner's next action may be, have found this practice extremely effective in expediting cases to early conclusion.

To offset any increased rigor of prosecution due to earlier final rejection, examiners are authorized to grant one interview after final rejection.

While the Office will continue rigorous enforcement of Rule 116, citation of new art by the Examiner in a final rejection will obviate further showing under Rule 116(b) for any amendment necessitated by the new art.

(4) The fourth change aids in shortening prosecution time by routine setting of four-month shortened statutory periods for response in nearly all first and subsequent rejections.

An exception will be made where a new reference is cited as a ground of rejection in the second Office action on the merits, the applicant in such cases being permitted the full statutory period of six months from the date of the Office action, except that where the new reference is necessitated by an amendment to the claims in applicant's first response, the normal four-month period will apply.

A related change directs that in case of an action consisting of only a requirement for restriction or in which the only rejection is for multiplicity, the period for response shall be set to expire two months from the date of the Office action.

Extension of time for reply will be governed by the provisions of Rule 136(b).

For the guidance of attorneys in knowing when their cases will be reached for action, the dates cited in the Official Gazette for each Group will consist of (1) effective U. S. filing date of the oldest case awaiting action in any examiner's docket, and (2) date of the oldest case awaiting first action.

It is apparent from the above stated priority of examination that only the old cases already under amendment will be acted upon for some months to come. It is hoped that thereafter, as a response to an action in any case is received, the case may be acted upon within the next month.

(5) The fifth major change affects interference practice. Effective July 1, 1964, interferences will not be declared between pending applications if there is a difference of more than three months in the effective filing dates of the oldest and next oldest applications, in the case of inventions of a simple character, or a difference of more than six months in the effective filing dates of the applications in other cases. If an interference is declared, all applications having the same interfering subject matter should be included.

## Part II - REVISED DOCKETING AND CLERICAL PROCEDURES

Docketing and clerical procedures to conform to the changed examining procedures will begin as soon as the June 30, 1964 inventory is completed, but before the Docket Record Cards are refiled.

The sequence of Serial Register Cards (PO-205) in the Master Reference File for all applications in the Group will continue unchanged, in numerical sequence according to serial numbers.

However, for the Docket Record Cards (PO-206) a new filing system will be used, based upon the "effective U. S. filing date" of each application, rather than the actual filing date.

For most cases, the "effective filing date" is the same as the actual filing date. Only in cases where claimed subject matter is entitled to the filing date of an earlier parent application will this "effective filing date" differ. These will include divisional applications, continuation applications, and, in some instances, continuation-in-part applications.

For cases awaiting action by the examiner, the two separate (PO-206) files of (1) new cases and (2) amended cases will be abolished, and replaced by a single file arranged in order of effective filing date.

Upon completion of inventory, the cards for each examiner's docket will first be filed in this single file in order of the actual filing date.

To accomplish the re-arrangement of these cards in each examiner's docket in order of the effective filing date, the following procedure should be followed.

As soon as possible after July 1, 1964, a file clerk or other person designated by each Clerk of Group shall inspect all files in each Group to identify all alleged divisional, continuation, and continuation-in-part applications, in which a parent case may prima facie entitle the application to an effective U. S. filing date earlier than the actual filing date.



For each such case, the filing date and serial number of the parent case, which constitute the "effective" filing date and "effective" serial number for the later case, shall be entered on both the Serial Register Card and the Docket Record Card for the later case, in ink immediately above the actual date and serial number.

The Serial Register Card (PO-205) will then be replaced in its original position in the Serial Register.

For the Docket Record Card (PO-206), however, the actual filing date will be ignored, and the card will be filed in order of its effective U. S. filing date.

Similar steps shall be taken for all cases now charged out upon their return to the Group, and for all new applications upon receipt in the Group.

The docket of rejected cards will continue to be filed according to months, numerically within each month. To distinguish between applications with the normal response period of four months and other applications, cards for applications given a shortened statutory period less than four months should be color-tabbed red in the upper right corner. Cards with response periods exceeding four months should be color-tabbed green in the upper left corner.

## COMPACT PROSECUTION

### OVER VIEW

1. Make the First Action thorough, clear and complete by:
  - a. Making the first search such that a second search is not necessary, unless necessitated by amendments to claims. First search should cover invention as described and claimed;
  - b. Explaining clearly the Office position on every essential factor in application; and
  - c. Pointing out wherever possible allowable claims, allowable claimed subject matter, or ways in which claims might be amended to make them allowable.
2. Make Second Action final by:
  - a. Allowing claims; or
  - b. Making an outright final rejection of some or all of the claims; or
  - c. Making a final rejection with suggestions for amendment under 37 CFR 1.116.

FINDINGS FROM QUALITY REINFORCEMENT PROGRAM SURVEYS

1. Newly applied art in subsequent actions should have been applied in a previous action in 50% of the applications surveyed.
2. Allowable subject matter was not indicated in 41% of the applications surveyed, where indication of allowable subject matter was deemed appropriate.

## COMPACT PROSECUTION

-3-

### How

1. Review applications for compliance with formal matters.
2. Understand the invention.  
(Do not limit understanding to just the claims.)
  - a. Read the Specification.
  - b. Note the objects of the invention.
  - c. Note any prior art and/or admissions.
  - d. Note any problems under 35 USC §§101, 112
3. Diagram all the claims.
4. Note any problems in interpreting the claims.
5. Review drawings, if any, for sufficiency.
6. Search the invention as described and claimed.
  - a. Search every class and subclass that may have material pertinent to subject matter as claimed.
  - b. Search art that covers subject matter that might reasonably be expected to be added to claims via response to First Action.
  - c. Speak to examiners having knowledge of art for advice.
7. Determine all appropriate rejections under prior art.
8. Determine any other issues that require treatment in Office action.
9. Write the First Office Action; include, as appropriate, treatment of following subject matter:

a. Comments/treatment of entry/non-entry of papers

- Preliminary amendments
- Missing pages/parts
- Claim numbering

b. Restriction requirements

- Election of invention
- Election of species

c. Non-art Rejections

- 35 U.S.C. 101
- 35 U.S.C. 112 1st and 2nd paragraph.

d. Art rejections

- 35 U.S.C. 102
- 35 U.S.C. 103
- Double Patenting

e. Indication of allowable subject matter

- Objected to claims
- Allowed claims
- Suggestions of allowable subject matter

COMPACT PROSECUTION EFFECTIVELY COMMUNICATING

-5-

REJECTIONS UNDER 35 USC 112f. Minor objections to the claims and Specification/  
application

- Oath or Declaration 112 (First or Second Paragraph)

- Drawings 112 (First or Second Paragraph)

- Abstract 112 (First or Second Paragraph)

- Specification 112 (First or Second Paragraph)

## g. Discussion of other prior art cited by the examiner

## h. Other

- Acknowledgment of other papers

- Miscellaneous comments

Note: Adequately explain reasoning and resulting position.  
Place yourself in position of reader; understanding that reader  
is not privy to discussions that took place or what is in writ-  
ter's mind. How can the Rejection be overcome?

EFFECTIVELY COMMUNICATING  
REJECTIONS UNDER 35 USC 112

The basic components of a Rejection under 35 USC 112 are:

1. Statute - 35 USC 112 (First or Second Paragraph).

2. What - Is not in compliance with the statute.

3. Why - It is not in compliance with the statute.

4. How - The Rejection can be overcome.  
(Optional)

### THE DESCRIPTION REQUIREMENT

The description requirement of the first paragraph of 35 U.S.C. 112 can be simply stated as follows:

The claimed subject matter must be described in the specification to ensure that applicant has in his possession, as of the filing of the application, the specific subject matter later claimed. See In re Wertheim et al, 191 U.S.P.Q. 90 (CCPA 1976).

It is not necessary that the applicant describe the claimed limitations exactly, but only so clear that one of ordinary skill in the art would recognize from the disclosure that applicant's invention included those limitations. See In re Smythe, 128 U.S.P.Q. 179 (CCPA 1973).

An example of non-compliance with the description requirement of 35 U.S.C. 112, first paragraph is the addition of new matter. If applicant claims subject matter not part of the original disclosure the claim should be rejected under 35 U.S.C. 112, first paragraph as failing to be supported by the original disclosure. See In re Rasmussen, 211 USPQ 323 (CCPA 1981).

#### Example:

The original disclosure is silent with respect to the time and temperature at which a rolled steel bar is annealed to relieve the internal strain resulting from the rolling process.

A newly presented claim now recites that the bar is annealed for 12 hours at a temperature of 800°F.

The rejection should be stated as follows:

(Form Paragraph 7.30)

Claim 1 is rejected under 35 U.S.C. 112, first paragraph as the specification as originally filed does not provide support for the invention as now claimed. The original disclosure fails to specify the exact time and temperature of the annealing process as now claimed. The annealing time of 12 hours and temperature of 800°F now claimed are considered to be new matter.



ANALYSIS OF THE DISCLOSURE  
UNDER 35 U.S.C. 112, FIRST PARAGRAPH

35 U.S.C. 112, First Paragraph

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention."

The first paragraph of 35 U.S.C. 112 requires applicant to disclose his invention to the public in such clear concise and exact terms as to enable any person skilled in the art to make and use the invention, and set forth the best mode for carrying out the invention. This requirement of 35 U.S.C. 112, first paragraph has been broken down into three separate questions. First, is the written description proper, second is the disclosure enabling and, third is the best mode disclosed. When communicating a rejection under 35 U.S.C. 112, first paragraph, the Examiner should clearly explain which of the above three requirements has not been complied with.

### THE BEST MODE REQUIREMENT

The best mode requirement of 35 U.S.C. 112, first paragraph is simply the requirement that applicant, to the best of his knowledge, set forth the best mode of operation or practice of his invention. Applicant may not conceal the specifics of the preferred invention and disclose to the public only the broad or second best mode of operation. Normally this rejection is made only after the Examiner has somehow discovered that the best mode is lacking.

#### Example:

The invention relates to a process for brazing ceramic to titanium. The inventor knows that one particular fluxing agent will produce the stated results, but fails to disclose that agent, disclosing instead only broad categories of fluxing agents.

In a similar case the Courts held that the best mode requirement has not been satisfied. See Union Carbide Corp. v. Borg-Warner, 193 U.S.P.Q. 1 (6th Cir. 1977).

The rejection should be stated as follows:

Claim 1 is rejected under 35 U.S.C. 112, first paragraph as failing to present the best mode of carrying out the invention. Applicant has failed to disclose the particular fluxing agent that results in the flaw free bond claimed. Since the record shows that the use of this specific fluxing agent results in a clearly superior bond and that applicant was aware of these results at the time the application was filed, the best mode requirement of 35 U.S.C. 112, first paragraph was not fulfilled.

## THE ENABLEMENT REQUIREMENT

If the disclosure fails to enable one of ordinary skill in the art to make and use the claimed invention then it is termed non-enabling. Key to the holding of non-enablement is the level of ordinary skill in the art. If one of ordinary skill could practice the invention without undue experimentation then the specification meets the enablement requirement of 35 U.S.C. 112, first paragraph. See In re Stephens et al, 188 U.S.P.Q. 659 (CCPA 1976).

### Example:

The disclosure is drawn to a method of using ultrasonic energy to mend broken bones. The specification merely discloses the use of "sufficient" ultrasonic energy to accomplish applicant's purpose. No specific example or statement is disclosed concerning the exact amount of energy to be used.

The Court ruled that, in the above case, the applicant had failed to meet the enablement requirement of 35 U.S.C. 112, first paragraph. See In re Colianni, 195 U.S.P.Q. 150 (CCPA 1977).

The rejection should be stated as follows:

(Form Paragraph 7.30)

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to teach how to make and/or use the invention, i.e. failing to provide an adequate disclosure. The disclosure fails to state or teach one of ordinary skill in the art the exact amount or duration of ultrasonic energy needed to mend the broken bone. Without this disclosure one of ordinary skill can not practice the invention.